

Before addressing the primary reference of Marble, it is worth noting that in the previous first and final office actions, the Examiner cited a patent to Richter in combination with Marble. It was argued by applicant that Richter was non-analogous art and therefore an improper reference. The Richter patent concerned reflectors studs for roads, and was not at all related to or suggestive of the present invention. The Richter patent was not cited in the current office action, but has been withdrawn by the Examiner.

The Marble patent teaches the use of bonding material between adjacent building blocks which are subject to expansion and erosion. However, Marble failed to address the movement of the entire joint on a different plane. The Examiner, however, noted that although the Marble patent disclosed a cap adjacent blocks with sealant material, Marble did not teach or suggest the ridges to increase the bonding area by 50% on the underside of the cap portion, which greatly improves the ability of the cap to protect the joints. Column1, line 36 of Marble states "The plastic bonding materials or joint fillers now used..." The use of plastic or other types did not allow adherence to the surface until modern sealants were developed. The use of the ridges as claimed in applicant's invention, allows the cap to become an integral part of the joint, and not merely rest on top of the joint. This allows for not only expansion and contraction, but also movement of the entire joint in a different plane. Without the ridges, the caps pulled away from the stone. The Marble patent prevented water intrusion caused by expansion and contraction of the bonding material. The fact that the present invention teaches elasticity, rather than a plastic member, allows it to integrally adhere to the joint and expand and contract with the joint.

Case Law Regarding Non-Analogous Art

Before the discussing the secondary patents cited by the Examiner, in combination with the primary reference, Marble, applicant asserts that an important principle covers the secondary patents cited against the claims. In short, most of the art cited, as will be discussed below, should be considered non-analogous art. It is well known in the case law that for art to be analogous art, it must at least suggest the invention, which this art does not. *In re Oetiker*, 977 F. 2d 1443, 24 USPQ 2d 1443, 1445 (Fed. Cir. 1992), stands for the proposition that "...a prior art reference must either be in the field of applicant's endeavor, or if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as the basis for rejection of the claimed invention."

Furthermore, "[T]hat all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art." *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865, 870 (CAFC 1983). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under [35 U.S.C.] Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hospital Systems v. Montefiore Hospital*, 221 USPQ 929, 933 (CAFC 1984) and cases cited therein (emphasis in original). Applicant has carefully examined the patents cited, and can find neither a teaching nor suggestion why it would be obvious to undertake the combination as claimed in the present invention.

To be specific, "[t]here is nothing in the prior art references, either singly or in combination, 'to suggest the desirability, and thus the obviousness,' of designing" an improved cap for sealed joints between adjacent blocks having a flexible body member which comprises a first cap portion and a leg portion; a plurality of ridges positioned on an underside cap portion, having a plurality of channels there between, the ridges further defining an increased area on the underside of the cap for sealant to adhere to; and the leg portion insertable into fluidized sealant material within the joint between the adjacent blocks, to a depth so that the underside of the cap portion imbeds into the sealant material for providing a sealed connection between the underside of the cap and the fluidized sealant material residing in the joint and on an upper surfaces of the adjacent blocks, or a method of applying same. *In re Deminski*, 230 USPQ 313, 315 (CAFC 1986) and cases cited therein (emphasis in original).

Applying the Non-analogous Art Standard to Marble/Jobe/Barton Combination

In the combination of Marble with Jobe et al., and Barton, the Examiner asserts that the '514 Jobe patent teaches ridges positioned on the underside of the cap portion to accommodate adhesive. In column 5, lines 45-46 state "... the shoulders 32 lay substantially flat along the edges of the joint. The other channel 38 is for receiving an adhesive." Applicant asserts that first the Jobe patent is teaching a pre cured caulk joint system, which does not indicate any types of ridges, particularly at the point noted by the Examiner. In combining the Marble and Jobe patents with Barton '260 patent, the Examiner cites column 3, lines 39 - 42 which state in part

“This adhesive, given the fact that there is increased surface area by virtue of the bevelled edge 24, promotes improved adhesive strength when the adhesive sets.” A reading of Barton does not indicate that the beveled edge has any type of ridges which would help increase surface area in the adhesion process. Furthermore, Barton is a patent addressing a system for joining structural panels and is not analogous to the art as taught by the present invention, as required *In re Oetiker, supra*.

Applying the Non-analogous Art Standard to the Other Section 103 References

Further, the Examiner rejected claims 1 - 12 under a series of patents in combination with Marble. Applicant will address these individually. Applicant first reiterates and adopts his arguments that made earlier in this response in the Marble/Jobe/Barton combination of references. The Examiner cited the Hahn ‘507 patent, which is a patent entitled “Ornamental Plastic Crown Molding.” Applicant would assert that crown molding is a stationary molding which is placed at the juncture between the ceiling and the wall. There is neither expansion nor contraction which is undertaken in crown molding, and even though there may be shallow groves and deep groves, as cited by the Examiner, the subject matter of this patent does not pertain to the subject matter of the present invention, an improved cap sealer for caulked joints, and would be considered non-analogous art.

Turning now to Marble in combination with the ‘214 patent, entitled “Cladding System,” once more, this system is completely unrelated to the present invention, and addresses a complicated system to secure a cladding material panel to a building structure including upper and lower bracket members. Applicant would assert that the system should be considered non-analogous art not pertinent in suggesting or teaching the present invention as claimed.

In combining Marble with the ‘353 patent, entitled “Backerboard for Ceramic Tile And the Like,” relates to placement of ceramic tiles on a floor surface. Once more, there is a rigid background on ceramic tiles when they are placed and glued down. However, ceramic tiles are being placed upon a structure which is secure and does not move as with the adjacent blocks as taught in using the present invention. Therefore, one would not refer to the ‘353 patent as being analogous art and fails to suggest the combination as taught in the claims of the present invention.

Reference is now made to the ‘643 patent, entitled “Automotive Space Frame Joining System.” Simply by its title, this patent addresses a space found in an automobile structure, such

as a space frame or an assembly for joining automobile chassis members to form automobile space frame structures. It goes without saying that this is perhaps the most non-analogous art cited by the Examiner, and fails to suggest or teach the combination of the present invention in combination with Marble.

In combining the Marble patent with '334 patent, entitled "Base for Roadway Marker," applicant would assert that this is an improper reference on two grounds. First, there are no ridges found in this base for roadway marker. If the Examiner is referencing to members 44, these are strengthening ribs which do not teach part of the combination of the present invention. Aecndly, as with the '643 patent, a base for a roadway marker constitutes art which is non-analogous art vis-a-vis the present invention.

In the '115 patent, entitled "Temporary Roadway Marker" in combination with Marble, applicant fails to see the pertinence of this reference. This is a reference which may show a parallel grove 16 or sharp pointed tooth 18 which claim to attach the roadway marker to the roadway surface. However, one would note that this patent is specifically addressing a roadway marker which is in no way analogous to the combination of the present invention. Therefore, this is an improper reference.

In regard to the '189 patent in combination with Marble, this patent is entitled "Mounting Base for Highway Markers." Again, as with the '115 patent noted earlier, this patent pertains to a particular type of apparatus for attaching a flexible marker shaft to a roadway. In reviewing the patent, applicant could not find any of the so called ridges as noted by the Examiner and if so, the operation of this apparatus is in an art that is unrelated to the present invention.

In the combination of Marble with the '538 patent again, this is a "Base for Roadway Marker and Method for Making Same." Again, applicant would argue that the manner that the apparatus is claimed and disclosed in this patent is in an art area that is totally unrelated to the present invention and again would suggest non-analogous art.

In citing of the '855 patent in combination with Marble entitled "Prefabricated Panel Having a Joint Thereon," applicant would assert that of the many joints taught by that particular patent (for example in figure 4) nowhere in the patent is it taught that ridges are formed on the undersurface of a cap member in order to allow the member better adhesion between two adjacent blocks. Therefore, not only does this patent not contain ridges in the combination as claimed in the present invention, but the patent addresses a joint which is a prefabricated joint

of adjoining panels, not adjacent blocks, and would be considered non-analogous art.

Again, applicant would make note of the *In re Oetiker, supra*, which stands for the proposition that “a prior art reference must either be in the field of applicant’s endeavor, or if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as the basis for rejection of the claimed invention.” (Emphasis underlined).

None of the references when combined with Marble teach the present invention. Furthermore, many of the references as noted earlier, do not comply with the standards as set forth by *In re Oetiker, supra*, and therefore should not be used in combination in order to render the claims of this patent application unpatentable.

Applicant would further note that in reviewing the various patents as cited by the Examiner, not one of the prior art patents reference Marble as prior art during the examination of the patent. That applicant would assert, is clear evidence that Marble is addressing a problem which is related the present invention, but, by itself, Marble does not disclose and claim the entire combination of the present invention, and none of the patents cited in combination with Marble suggest that combination as analogous art. Therefore, claims 1-12 are therefore patentable over the art.

Applicant would assert that the claims are patentable over the art cited, and would request re-examination of the claims and a notice of allowance.

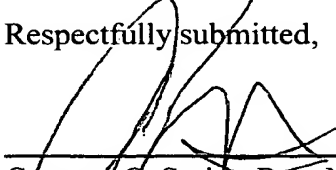
Should the Examiner feel that a telephone conference would advance the prosecution of this application, he is encouraged to contact the undersigned at the telephone number listed below.

Applicant respectfully petitions the Commissioner for any extension of time necessary to render this response timely.



Please charge any fees due or credit any overpayment to Deposit Account No. 50-0694.

Respectfully submitted,



Gregory C. Smith, Reg. No. 29,441
Charles C. Garvey, Jr., Reg. No. 27,889
Seth M. Nehrbass, Reg. No. 31,281
Stephen R. Doody, Reg. No. 29,062
Brett A. North, Reg. No. 42,040
GARVEY, SMITH, NEHRBASS & DOODY, L.L.C.
PTO CUSTOMER NO. 22920
3838 N. Causeway Blvd., Suite 3290
Metairie, LA 70002
Telephone: (504) 835-2000; 835-2070 (fax)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Responses, Commissioner for Patents, P. O. Box 1450 Alexandria, VA 22313-1450, on May 22, 2003.



Gregory C. Smith, Reg. No. 29,441

RECEIVED
JUN 04 2003
GROUP 3600

RECEIVED
JUN 02 2003
TECHNOLOGY CENTER-R3700